

Remarks

I. Status of claims

Claims 1-24 are pending. Claims 4 and 17 have been amended.

II. Allowed claims

Claims 5-7, 9-14, 20, and 21 have been allowed.

III. Claim rejections under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1, 3, 10, 15, and 18 under 35 U.S.C. § 103(a) over Carlotta (U.S. 5,400,060) in view of Sneed (U.S. 5,521,002).

A. Claim 10

Claim 10 depends from independent claim 6, which has been allowed. For at least this reason, the Examiner's rejection of claim 10 should be withdrawn.

B. Claims 1, 3, 15, and 18

1. The Examiner's Rejection is Improper Because the Examiner has Failed to Provide any Motivation for Combining the Reference Teachings

Each of claims 1, 3, 15, and 18 requires a moisture retardant film bonded to a hot melt film or layer. In response to Applicants' arguments, the Examiner has indicated that (emphasis added):

Carlotta teaches the base film is made of plastic material such as polyester. Because Carlotta does not further specify whether such polyester is moisture retardant or not, Examiner is therefore seeking a reference, which teaches a subject matter that is made of polyester and this polyester is moisture retardant. Sneed actually teaches a base material, which is humidity resistant. Humidity resistant is the same as moisture retardant, however, expresses in different term. ... As

discussed above, some polyester is water-permeable or semi-permeable (furnished by the Applicants), the polyester material proposed by Sneed is, however, humidity resistant. Sneed's polyester, to the Examiner's understanding is not all of the polyester, also, is of a special kind, which is humidity resistant. ... So long as Sneed provides a humidity resistant base material, other such as for archival storage of master prints, etc. are its intended use, which carries less patentable weight, *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In sum, the Examiner acknowledges that Carlotta teaches that a flexible, tear resistant film layer 30 of a seal 28 may be made of polyester, but Carlotta does not teach or suggest anything that would have motivated one of ordinary skill in the art at the time of Applicants' invention to select a moisture retardant form of polyester for the tear resistant film layer 30. Nevertheless, the Examiner concludes that claims 1, 3, 15, and 18 would have been obvious to one of ordinary skill in the art at the time of Applicants' invention because Sneed teaches that at least some kinds of polyester are humidity resistant. The Examiner, however, has applied an incorrect standard for determining obviousness under 35 U.S.C. § 103(a).

In particular, among the criteria the Examiner must meet in order to establish a proper *prima facie* case of obviousness, the Examiner must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of Applicants' invention, to modify the references or to combine reference teachings" (MPEP § 706.02(j)). The Examiner has failed to make such a showing. In particular, the Examiner has failed to explain why, when faced with the wide variety of different types of polyester films that is available, one of ordinary skill in the art at the time of Applicants' invention would have selected the particular humidity resistant polyester film described in Sneed as the type of polyester used to form the flexible, tear resistant film layer 30 in the removable ink jet cartridge seal 28 described in Carlotta.

It appears that the Examiner has improperly engaged in hindsight reconstruction of the claimed invention, using applicants' disclosure as a blueprint for piecing together prior art to defeat patentability. Without a proper explanation for combining these references, the Examiner has failed to establish a proper *prima facie* case for obviousness and the rejection should be withdrawn.

2. The Examiner's Rejection is Improper Because Sneed is Non-Analogous Art

To support a rejection under 35 U.S.C. 103(a), the references relied upon must be either in the field of the Applicants' endeavor or reasonably pertinent to the specific problem with which the Applicants was involved.

The invention recited in claims 1, 3, 15, and 18 relates to the field of print cartridges. Sneed, on the other hand, relates to the field of print media. Print cartridges and print media do not have sufficient similarity of structure and function as to be considered to be the same field of endeavor under 35 U.S.C. § 103(a). For example, print cartridges have reservoirs for containing ink and nozzles for delivering ink to a print medium, whereas print media have substrates configured to receive ink. Clearly, the structure and function of a print cartridge designed to contain ink and mark a print medium with ink is significantly different from the structure and function of a print medium designed to receive ink. For at least these reasons, Sneed is not in the same field of endeavor as the invention recited in claims 1, 3, 15, and 18.

In addition, Sneed is not reasonably pertinent to the specific problems solved by the invention of claims 1, 3, 15, and 18 and, therefore, Sneed is not analogous art. In particular, the specific problems addressed by the invention of claims 1, 3, 15, and 18 and the specific problems addressed by Sneed are significantly different such that one of ordinary skill in the art at the time of Applicants' invention at the time of the invention would not have been expected or motivated to look to the Sneed reference to solve the specific problems addressed by the invention of claims 1, 3, 15, and 18. For example, one object of the invention recited in claims 1, 3, 15, and 18 is to seal nozzles on print cartridges after manufacture and prior to use. Sneed, on the other hand, does not teach or suggest anything relating to seals, much less anything relating to seals for print cartridge nozzles.

In conclusion, Sneed is not in the same field of endeavor and is not reasonably pertinent to the specific problem solved by the invention of claims 1, 3, 15, and 18. Therefore, Sneed is non-analogous art and is not properly citable against claims 1, 3, 15, and 18 under 35 U.S.C. § 103(a).

Since, Carlotta fails to teach or suggest a laminate for sealing nozzles on print cartridges that includes a moisture retardant film bonded to a hot melt film or layer, as recited in claims 1, 3, 15, and 18, and Sneed is not properly citable against the claims, the Examiner's rejection of claims 1, 3, 15, and 18 under 35 U.S.C. § 103(a) over Carlotta in view of Sneed should be withdrawn.

C. Claim 2

Claim 2 incorporates the features of independent claim 1 and, therefore is patentable for at least the same reasons explained above. Claim 2 also is patentable for the following addition reasons.

In response to Applicants' arguments, the Examiner has indicated that:

Regarding claim 2, Iwasaki reference, before going into details, the bottom line of the base film is "moisture retardant." Then Iwasaki teaches a base film or substrate (31) which is moisture resistant. Therefore, Examiner contends this base film can also apply to the instant invention as the base film in making the laminate to seal nozzles on print cartridge. As to the motivation of combining, "maintaining a stability of the sensitivity of the photosensitive recording medium so that the image quality is maintained at a high grade" is an extra feature other than the base film or substrate can be moisture resistant. It is therefore, so long as the base film presents moisture resistant, and the material of the base film is such as polyester or polyolefin, this meets the limitation in the claim. Other features that are other than moisture retardant taught by the teaching references such as Sneed or Iwasaki are their intended use. Although as Applicants argue that it is irrelevant to the instant application, it is however, those teachings have a common point, i.e., the base film or the substrate has the characteristics of "humidity resistant" or "moisture resistant," which in fact are the same as "moisture retardant" as in the instant application, only expressed in different terms. Therefore, using those references in combining with Carlotta reveals a laminate having a base film, which is "humidity resistant" or "moisture resistant".

As in the rejection of claims 1, 3, 15, and 18, the Examiner has applied an incorrect standard for determining obviousness of claim 2 under 35 U.S.C. § 103(a). In particular, the Examiner has failed to make the required showing that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of Applicants' invention, to modify the references or to combine reference teachings" (MPEP § 706.02(j)).

As explained above, Sneed merely teaches that his matte ink receiving media may include a particular type of polyester substrate that exhibits certain properties that are useful

for an ink receiving medium. Iwasaki indicates that an amorphous polyolefin material may be used as or coated on the transparent substrate 31 and the sheet-like substrate 35 of a photosensitive recording medium. The Examiner asserts that the teachings of Sneed and Iwasaki "have a common point, i.e., the base film or the substrate has the characteristics of 'humidity resistant' or 'moisture retardant'." But neither reference, taken alone or in any permissible combination, teaches anything that would have led one of ordinary skill in the art at the time of Applicants' invention at the time of the invention to select a polyolefin film for Carlotta's flexible, tear resistant film layer 30. The fact that Iwasaki uses moisture resistant amorphous polyolefins in a photosensitive recording medium is completely unrelated to Carlotta's ink jet cartridge face sealing and does not provide any motivation for one of ordinary skill in the art at the time of Applicants' invention to replace Carlotta's flexible, tear resistant film layer with the polyolefin layer described in Iwasaki.

Once again, it appears that the Examiner has improperly engaged in hindsight reconstruction of the claimed invention, using applicants' disclosure as a blueprint for piecing together prior art to defeat patentability. Without a proper explanation for combining the cited prior art based on the prior art teachings, the Examiner has failed to establish a proper *prima facie* case for obviousness and the rejection should be withdrawn.

Additionally, for reasons similar to those explained above in connection with Sneed, Iwasaki is not in the same field of endeavor and is not reasonably pertinent to the specific problem solved by the invention of claim 2. Therefore, Iwasaki is non-analogous art and is not properly citable against claim 2 under 35 U.S.C. § 103(a).

For at least these additional reasons, the Examiner's rejection of claim 2 under 35 U.S.C. § 103(a) over Carlotta in view of Sneed and Iwasaki should be withdrawn.

D. Claim 19

Claim 19 incorporates the features of independent claim 18 and therefore claim 19 is patentable for at least the same reasons explained above. Claim 19 also is patentable for the following additional reasons.

The Examiner has indicated that:

Regarding claim 19, Hartz reference, similar to the discussion above, what Hart's teaching is a pouch material including

aluminum foil, heat resistant polyester film, paper/polymer laminates, and other moisture resistant polymer film. Still, Hartz's teaching meets the bottom line, the material is "moisture retardant." Others are its intended use.

Hartz discloses "a disposable heat storage unit of the kind comprising a latent heat substance positioned within a thermal transfer pouch" (col. 1, lines 4-6). Hartz does not teach or suggest anything relating to heat staking a moisture retardant pouch material to a hot melt layer that is applied over nozzles of a print cartridge, as required by claim 19. Contrary to the Examiner's assertion, the bottom line is not that Hartz' material is moisture retardant. Rather, under 35 U.S.C. § 103(a), the Examiner carries the burden of showing that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of Applicants' invention, to modify the references or to combine reference teachings" (MPEP § 706.02(j)).

It appears that the Examiner again has improperly engaged in hindsight reconstruction of the claimed invention, using applicants' disclosure as a blueprint for piecing together prior art to defeat patentability. Without a proper explanation for combining the cited prior art based on the prior art teachings, the Examiner has failed to establish a proper *prima facie* case for obviousness and the rejection of claim 19 should be withdrawn.

In addition, Hartz's teaching that pouch 2 may be moisture resistant would not have motivated one of ordinary skill in the art at the time of Applicants' invention to heat stake a moisture retardant pouch material to a hot melt layer that is applied over nozzles of a print cartridge, as required by claim 19. Indeed, none of the cited references teaches or suggests anything that would have led one of ordinary skill in the art at the time of Applicants' invention at the time of the invention to seal a print cartridge in the manner recited in claim 19.

For at least these additional reasons, the Examiner's rejection of claim 19 under 35 U.S.C. § 103(a) over Carlotta in view of Sneed and Hartz should be withdrawn.

E. Claims 4, 8, and 17

The Examiner has rejected claims 4, 8, and 17 over Carlotta in view of Sneed and Karita (U.S. 5,850,238).

Dependent claim 8 incorporates the features of independent claim 6, which has been allowed. For at least this reason, the Examiner's rejection of claim 8 should be withdrawn.

Dependent claim 4 incorporates the features of independent claim 1 and dependent claim 17 incorporates the features of independent claim 15. Therefore, these claims are patentable for at least the same reasons explained above.

The Examiner has acknowledged that Carlotta and Sneed do not teach or suggest sealing electrical contacts and leads on print cartridges. The Examiner, however, has indicated that (emphasis added):

Regarding Karita's et al. ... the opening (1700) is sealed by the tape (3), electric contact (201) is inside or under the tape (3). Therefore, it can be considered the electric contact (201) is sealed by the tape (3), although the tape (3) does not directly contact with the electric contact (201), it is however, under the cover of the tape (3).

Claim 4 has been amended to recite that the laminate contacts and seals electrical contacts and leads on print cartridges against corrosion. Claim 17 has been amended to recite the step of "heat staking the tape over and in contact with the electrical contacts and leads as well as the nozzles." Since, the Examiner has acknowledged that Karita does not teach or suggest that tape (3) could contact electric contact (201), the Examiner's rejection of claims 4 and 17 under 35 U.S.C. § 103(a) over Carlotta in view of Sneed and Karita now should be withdrawn.

E. Claims 22-24

The Examiner has indicated that he maintains his rejection of claims 22-24 under 35 U.S.C. § 112, second paragraph, because they recite certain trademarks/tradenames. However, in the Response filed March 26, 2003, these claims were amended to recite the generic chemical compositions corresponding to the previously recited trademarks/tradenames.

For at least this reason, the Examiner's rejection of claims 22-24 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

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IV. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

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